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| 10/032,684      | 10/22/2001  | Thomas R. Wulff      | 83573RLO            | 7300             |

7590

03/24/2006

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EXAMINER

ZURITA, JAMES H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3625

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/032,684

Applicant(s)

WULFF ET AL.

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Prosecution History***

The following is presented to clarify the record.

On 22 October 2001, applicant filed the instant application.

On 16 August 2004, the Examiner rejected claims 1-9 as unpatentable over Lockhart (US 6,732,152) in view of Fredlund (US 5,666,215).

On 20 October 2004, applicant amended claims 1, 2, 8-9.

On 6 January 2005, the Examiner issued a final rejection of claims 1-9 as unpatentable over Lockhart and Fredlund, above.

On 16 February 2005, applicant requested continued examination. Applicant cancelled claims 1 and 6, added claim 10 and amended claims 2-9.

On 15 May 2005, the Examiner rejected claims 2-10 as unpatentable over Lockhart and Fredlund, above.

On 18 November 2005, Applicant amended claim 10.

### ***Response to Amendment***

Applicant's submission of 18 November 2005 has been entered.

Claims 2-5, 7-10 are pending and will be examined.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (US 6,732,152).

Lockhart discloses methods and systems for printing and delivering images from digital image files from one or more recipients.

**As in claim 10(a)**, a consumer electronically **transmitting** digital images and consumer information including image locator Information, recipient location information and [other] demographic information identifying the consumer or recipient, from a consumer location remote from and over a communication channel to a central receiving agency which stores such digital image(s) and locator information in memory. Lockhart discloses that a consumer may electronically transmit digital images to a server at a centralized location (applicant's central receiving agency); see, for example, references to uploading images and file creation, at least Col. 5, line 40-Col. 7, line 4. A consumer may also upload demographic information that identifies the consumer or recipient; see, for example, at least references to demographics, Col. 15, line 46-64.

A consumer may transmit digital images from location(s) remote from a server on the network; see, for example, at least references to customers at client devices sending images to servers over communication channels such as the Internet, Fig. 1 and related text. The receiving agency, at a server, receives and stores digital images and other information in memory. See, for example, at least references to mail service computer 110 and associated storage, including databases. See also at least references to Image collections stored in databases, at least Col. 7, lines 5-20. The

central receiving agency provides locator information to locate the images after a customer uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images, such as a customer's images.

**As per claim 10(b)**, b) a plurality of sponsors each electronically **transmitting** at least one sponsor digital image and [other] demographic requirements identifying consumers and recipients to the central receiving agency. Lockhart discloses that advertisers, media collection providers, partners and other parties (applicant's sponsors) may electronically transmit at least one sponsor digital image from a remote location, over a communications channel such as the Internet, to a server at a centralized location (applicant's central receiving agency). See, for example, at least references to image collections, partner web sites, Col. 6, lines 53-64. As above, the central receiving agency provides locator information to locate the images after a sponsor uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images.

**As per claim 10(c)**, the consumer identifying a particular stored image in the memory using the corresponding image locator information and the recipient location information of one or more recipients. Lockhart discloses that a consumer may identify a particular stored image using the corresponding image locator information and the location of one or more recipients. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least references to recipient location indicators, such as New Home/Address links in Fig. 3.

**As per claim 10(d)**, the central receiving agency **selecting** one or more sponsor's digital image(s) based upon a correlation between [other] demographic information provided by the consumer and the [other] demographic requirements provided by the sponsor(s). Lockhart discloses that a central agency may select one or more sponsor digital images based upon correlation of [other] demographic information and demographic requirements of sponsors. See references to targeting advertisements by demographic criteria. Along with various images, including advertising images, sponsors may transmit demographic requirements identifying consumers and recipients. For Advertisers as sponsors, please see at least Col. 15, lines 46-63. Sponsors may specify at least some of their digital images, which based upon a correlation between a sponsor's demographic requirements and demographic information that was provided by a consumer, identify at least some of the sponsor's digital images. See, for example, at least references to geographically-targeted advertisements and advertisements based on consumer demographics at least in Col. 15, lines 23-Col. 16, line 24.

**As per claim 10(e)** the central receiving agency merging into a digital image file the consumer identified digital image(s) and the corresponding selected sponsor digital image(s) selected by the central receiving agency. Lockhart discloses merging into a digital file the consumer identified digital image and the corresponding sponsor digital images. See, for example, at least references to merging consumer images and sponsor images and text, at least Col. 10, lines 56-67; Col. 3, line 59-Col. 4, line 20.

**As per claim 10(f)**, transmitting the corresponding merged digital image file for the identified particular stored image in the memory and display such image and the merged information to the printing location of the consumer or identified recipient(s). Lockhart discloses transmitting the corresponding merged digital file for the identified particular stored image in the memory and display such image and the merged information to the printing location of the consumer or identified recipients. See, for example, at least references to reviewing, Col. 11, line 53-Col. 12, line 40. A consumer may preview merged digital files at his printing location, home computer-client site via a web browser, for example. See also at least Fig. 4, item 404, which shows an image that may be previewed at a recipient's location.

**As per claim 10(g)**, printing the merged digital image file at the printing location corresponding to consumer identified recipient(s) and delivering the printed merged image file, in a package or postcard to the location corresponding to the recipient(s). Lockhart discloses printing the merged image at the printing location corresponding to consumer-identified recipients. See at least Col. 14, lines 27-63. Lockhart discloses delivering printed merged images to locations corresponding to the recipients; see at least Delivery, Col. 14, lines 63-Col. 15, line 7. See also references to printing and sending a mail item, at least Col. 12, lines 14-41.

**As per claim 10(h)**, the sponsor making at least partial payment to the central receiving agency for the printing and delivering the merged digital image file. Lockhart discloses sponsor(s) making at least partial payment to the central receiving agency for the printing and delivering the merged digital file. See, for example, at least references

to advertising potential, partial or complete underwriting of postage by sponsors, at least Col. 15, line 65-Col. 16, line 16.

**As per claim 10**, Lockhart **does not** specifically disclose merging files and including them in a package. Fredlund discloses uploading and merging music or voice files, and delivering them to customers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

As per claim 10, Lockhart **does not** specifically disclose that demographic information specifically excludes demographic information derived from address information. Lockhart states in part, Col. 15, lines 45-55,

Indeed, the advertisements may be based on precise **demographic** data derived in part from the recipient's address information.

Lockhardt does not limit himself on address information, but specifically states that demographic data is *derived in part from such address information*, clearly denoting that other user [demographic] information is used to derive **precise** demographic data.



Official Notice is taken that demographics is the statistical characteristics of human population (as age or income) used especially to identify markets.<sup>1</sup> It would have been within the skill of one of ordinary skill in the art at time of invention to include other sources of demographic information. One of ordinary skill in the art at the time the invention was made would have been motivated to derive demographic information concerning a user from information other than address information for the obvious reason that such information, such as age and income, for example, is often useful in helping to identify markets.

**As per claim 2**, Lockhart discloses that electronically transmitting and the identifying steps are preformed simultaneously. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least references to recipient location indicators, such as New Home/Address links in Fig. 3.

**As per claim 3**, Lockhart discloses that the recipient location information includes a distribution list originally resident in a personal computer or in a central server managed by the central receiving agency. See, for example, at least references to selecting destination addresses from address books, Fig. 2 and related text. See also Addressing, Col. 10, lines 40-55.

**As per claim 4**, Lockhart discloses that the recipient location information includes the address of each of the recipients and wherein the printed image is delivered by mail .to the address of each of the recipients. For recipient addresses, see

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<sup>1</sup> Definition of demographics, MERRIAM WEBSTERS Collegiate Dictionary.

at least Addressing, address books, Fig. 2 and related text, and Col. 10, lines 40-55.

The printed images are delivered by mail to recipient's addresses, as seen in Delivery, Col. 14, line 64-67. See also Fig. 1 and related text, including description of item 120, surface mail.

**As per claim 5**, Lockhart discloses that sponsor digital images may include advertising information. See at least references to advertisements, Fig. 3, related text and Col. 15, line 46-Col. 16, line 17.

**As per claim 8**, Lockhart discloses that the package includes a digital video. See, for example, at least references to video image capture, Col. 9, line 60-Col. 10, line 2. See also references to user graphic images such as might provided by a digital camera, motion video camera and others, at least Col. 4, line 42-Col. 5, line 9.

**As per claim 9**, Lockhart discloses that the central receiving agency provides bills or charges to the consumer and the sponsor for the printing and delivery of the package. See, for example, at least references to account balances, postcard purchases, Col. 11, line 53-Col. 12, line 14.

**Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (US 6,732,152) in view of Fredlund et al. (US 5,666,215).

**As per claim 7**, Lockhart **does not** specifically disclose that a package may include a digital audio file. Lockhart discloses customizing cards for particular occasions, such as birthdays and anniversaries. **Fredlund** discloses uploading and merging music or voice files. See, for example, at least Fig. 1 and related text. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

### ***Response to Arguments***

Applicant's arguments filed 18 November 2005 have been fully considered but they are not persuasive.

Concerning demographic information, Applicant argues:

Element (a) of claim 10 requires that the consumer electronically transmitting digital image an demographic information identifying the consumer or recipient. in discussing Lockhart et al. with respect to this claim feature, the examiner states "A consumer may also upload demographic information that identifies the consumer or recipient; see, for example, at least references to *demographics*, Col. 15, lines 46-54". Lockhart et al., however, actually states "Indeed, the advertisements may be based on precise demographic data derived in part from the recipient's address information." Emphasis added, col. 15, lines 53-55. Thus, the only reference to demographic data in Lockhart et al. is demographic data derived from address information entered by the consumer. Lockhart et al. therefore does not disclose or suggest having a consumer enter demographic information as required in element (a) of claim 10.

The examiner may suggest that the address information of the recipient constitutes demographic data. In order to clarify the difference between demographic data and address information, applicants have amended claim 10 to point out that the consumer information entered by the consumer includes *both* recipient location information and demographics information. Accordingly, the address information disclosed in Lockhart et al. does not constitute demographic information as stated by the examiner.

The Examiner notes that applicant provides no definition for *demographics*.

Since applicant has provided no explicit definition for the above terms, the Examiner relies on the term's ordinary meaning and broadest reasonable interpretation. *E-Pass*

*Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003). The Examiner notes the definition of demographics: the statistical characteristics of human population (as age or income) used especially to identify markets.<sup>2</sup> It is also not clear whether Applicant now defines *demographics* to specifically exclude the use of addresses.

Applicant argues,

...however, Lockhart et al. fails to disclose or suggest other elements of the claims at issue. Claim 10, for example, also requires that the central receiving agency merge into a digital image file the consumer identified digital image(s) and the corresponding selected sponsor digital image(s). The examiner states "Lockhart discloses merging into a digital file the consumer identified digital image and the corresponding sponsor digital images. See, for example, at least references to merging consumer images and sponsor images and text, at least Col. 10, lines 56-67" In fact, there is no disclosure or suggestion at the cited location to merge sponsor selected digital images with consumer selected images. Instead, the paragraph generally refers to merging "...variable text or variable data (addresses, names, etc.)..." than can be "...incorporated into the final mail item's text note." Thus, the cited paragraph appears to be discussing only text information.

In response to these arguments, the Examiner respectfully directs Applicant's attention to other portions of Lockhart which clearly note that images and text are included, as in Col. 3, line 59-Col. 4, line 20.

Applicant argues

Applicants note other portions of Lockhart et al. discuss allowing the user to select image information that is to be incorporated in the mail file. For example, Lockhart et al. states "In addition to suitable communication software, user system 102 may also include client software which allows the user to select regions of the displayed image for inclusion in the mail file and, ultimately, the printed mail item." Col. 4, lines 53-56. See also, col. 6, lines 52-56. which states in part "...mail service computer 10 which includes a plurality of graphical images that the user may select...". In each case, however, the images are always selected by the user and not selected by the sponsor.

In response to these arguments, the Examiner notes that even in the section cited by applicant, it is a sponsor who selects what images and text are included in the system to begin with, as the images are advertisements selected by real-estate offices,

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<sup>2</sup> Definition of demographics, MERRIAM WEBSTERS Collegiate Dictionary.

car dealerships and other endeavors that send images and text associated with the enterprises.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

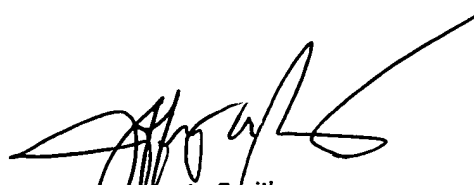
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*JZ*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
19 March 2006

  
Jeffrey A. Smith  
Primary Examiner